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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,592	01/28/2002	Valdemar Portney	13879	5114

7590

02/02/2004

SHELDON & MAK  
9th Floor  
225 South Lake Avenue  
Pasadena, CA 91101

EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/02/2004

*13*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/058,592

Applicant(s)

PORTNEY, VALDEMAR

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,2,5,7,13 and 15 is/are allowed.
- 6) ☒ Claim(s) 3,4,6,8-12,14 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The examiner was unable to locate a copy of a substitute set of drawings with the Applicant's Response received on December 1, 2003. Therefore, the following is repeated from the previous Office action:

The drawings are objected to because Figures 10 and 11A-C should be labeled as "Prior Art". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The terminal disclaimer filed on December 1, 2003, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,152,959 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 102(a) as being anticipated by Lee, WO 99/62434.

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Figure 5(b) includes an optic **3** and fixation members **5** each having pincer arms **8** and **34** between which is a side region. There exists at least one location on the pincer arm **8** and at least one location on the pincer arm **34** or the connecting element such that the points are equidistant from a central-most portion of the pincer gap between the two arms, as evident from the drawing and from the purpose of the arms **8** and **34** (page 11, lines 22-24; page 13, lines 19-21; etc.). The structure depicted is *capable* of providing a gripping site for forceps in a combination instrument, whether or not such was the intent, in view of page 14, lines 9-19; page 17, lines 8-23; etc. (*Claim 14 is believed to have support in parent US 6,342,058 but not in grandparent US 6,152,959.*)

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, WO 99/62434. Each pincer arm **8** being spaced from a respective pincer arm **34** by some amount within the range of about 1 mm to about 3 mm would have been obvious in order to provide adequate anchorage (page 15, lines 11-13) and/or to enable the surgeon to view the arm **8** (page 17, lines 11-13).

Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krumeich, WO 00/74601 A1. Figure 1 shows an optic **1**, a side region **4**, connecting elements between the optic **1** and the side region **4**, and pincer arms forming a narrow pincer gap **3**. The functions of the components are explained in the English abstracts.

Claims 3, 4, 6, 8-12, and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tran et al., US 6,395,028 B1. Regarding claim 22, the features defined by elements **16**, **18**, and **20** are certainly *capable* of accommodating an enclavation needle and forceps instrument, whether or not such was the intent. Regarding claims 9-12, the transverse

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members and the orthogonal member are defined around the manipulation holes **18**, with the central portion being that portion of the band **21** which lies along the slot next to the pincer arms **20**.

Claims 1, 2, 5, 7, 13, and 15 are allowed.

The Applicant's remarks have been reviewed and have been adequately addressed in the grounds of rejection above. The added language pertaining to the substantial uniform width of the pincer gap (claim 1) and the alteration of the scope of claims 14 and 15 necessitated the new grounds of rejection. Therefore:

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

This application contains claims 16-22 drawn to a species nonelected in Paper No. 6; the Applicant is asked to cancel these claims (MPEP 821.02).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**